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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,602	08/23/2002	Jorg Bernard	05638.0018	6889
22852	7590	11/13/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER WONG, LESLIE A	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 11/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10088602	8/23/02	BERNARD ET AL.	05638.0018

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**EXAMINER**

Leslie Wong

ART UNIT	PAPER
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1794

20071109

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

The information disclosure statement filed August 28, 2007 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. It is specifically noted that JP11-507243 was not considered. No explanation was provided and a translation was not received.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is 571-272-1411. The examiner can normally be reached on Tuesday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Leslie Wong  
Primary Examiner  
Art Unit: 1794



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/088,602  
Filing Date: August 23, 2002  
Appellant(s): BERNARD ET AL.

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David Forman  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 3, 2007 appealing from the Office  
action mailed September 19, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,578,339	Kunz et al.	11-1996
6,248,386	Willibald-Ettle et al.	6-2001

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant does not clearly teach what is encompassed by "reduced water uptake." The specification does not define this phrase and the use of this phrase does not clearly set forth limits on the claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al (US Patent No. 5578339) and Willibald-Ettle et al (US Patent No. 6248386).

Kunz et al disclose the use of 1,1-GPM and sorbitol in candy (see entire patent, especially claims 5, 8, 21, and 22).

Willibald-Ettle et al disclose hard caramels comprising 1,1-GPM and sorbitol (see entire patent, especially claims 9 and 12).

The claims differ as to the specific amounts employed.

In the absence of a showing to the contrary, the amounts employed are no more than a matter of choice and well-within the skill of the art and at most are deemed to be optimization, *In re Boesch* 205 USPQ 215. Applicant is using known components for their art-recognized function to obtain expected results.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made to use the claimed percentages in either Kunz et al or Willibald-Ettle et al because the use and manipulation of both 1,1-GPM and sorbitol are conventional in the production of hard candies such as caramels.

#### **(10) Response to Argument**

Appellant argues that "reduced water uptake" is an indicator of improved stability, that the phrase "reduced water uptake" is reasonably clear, and that the working examples provide methods for assessing whether water uptake is reduced. Appellant refers to page 3, lines 1-8 and pages 9-13 of the specification.

On page 3, water uptake is discussed as "(t)he hard caramels according to this invention are surprisingly characterized by an especially low water uptake." Appellant does not discuss a reduced water uptake or compare the water uptake to any sort of standard. Pages 9-13 contain examples with Examples 3 and 4 specifically directed to hard caramels. Examples 3 and 4 contain 1,1-GPM and sorbitol **and** also contain mannitol and GPS. Appellant does not teach, as set forth in claim 1, a hard caramel

with "reduced water uptake" containing 1,1-GPM in an amount of 52 wt% to 60 wt% (based on the total dry solids of the hard caramel) and sorbitol in an amount of 0.5 wt% to 3.5 wt%. Appellant references water uptake but does not teach a reduced water uptake for a hard caramel containing 1,1-GPM and sorbitol.

Appellant argues that the prior art teaches away from the claimed invention, that there is no motivation to combine the teachings of the prior art, and that the claimed invention provides unexpected results.

Both Kunz et al or Willibald-Ettle et al teach the conventional use of 1,1- GPM and sorbitol in the production of candy/caramel.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the prior art is directed to the conventional use of 1,1-GPM and sorbitol in the production of candy/caramel.

Kunz et al teach a sweetener, for use in the preparation of candy, containing 45 to 60% by weight 1,1-GPM and small amounts of sorbitol (see claims 5 and 8). This does not differ from the claimed invention. Kunz et al does not exclude sorbitol. It is

further noted that Kunz et al teach additional components including 1,6-GPS, 1,1-GPS, mannitol, and hydrogenated or non-hydrogenated starch oligosaccharides (see claim 8). It is also noted that Appellant's reference to unsatisfactory products (column 1 of Kunz et al) is not relevant as the cited lines refer to 1,6-GPM not the claimed 1,1-GPM.

Willibald-Ettle et al teach disclose hard caramels comprising 1,1-GPM and sorbitol (see entire patent, especially claims 9,10, and 12). Willibald-Ettle et al also teach additional components including 1,6-GPS, 1,1-GPS, mannitol, and hydrogenated or non-hydrogenated starch hydrolyzates (see claim 9).

Neither Kunz et al nor Willibald-Ettle et al teach the exclusion of sorbitol. Both Kunz et al and Willibald-Ettle et al teach the conventional use of 1,1-GPM and sorbitol as sweeteners. Appellant uses art recognized components for their art recognized function to obtain no more than expected results.

The declaration under 37 CFR 1.132 filed November 28, 2005 is insufficient to overcome the rejection of claims 1-12 based upon 35 U.S.C. 103(a) for the following reasons.

- 1) The showing is not commensurate in scope with the broadest claim.
- 2) There is no analysis of data and the results appear to be no more than expected.

The declaration under 37 CFR 1.132 filed August 16, 2006 is insufficient to overcome the rejection of claims 1-12 based upon 35 U.S.C. 103(a) for the following reasons.



1) The showing is not commensurate in scope with the broadest claim. Claim 1 does not contain GPS nor does it list storage conditions. Applicant does not explain the choice of limitations. It is not apparent what results would be obtained at different conditions (e.g. a longer or shorter storage time). GPS is a limitation of claim 10.

2) There is no analysis of the data.

Appellant's showings are not commensurate in scope with the broadest claim. The showings contain additional components which are not addressed.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



**Leslie Wong**  
**Primary Examiner**

Conferees for Pre-Appeal Brief Review:

Milton Cano  
Jennifer Michener